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10/692,835	10/23/2003	Martine Fennelly	FLEECE.001A	9218

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EXAMINER

NGUYEN, SON T

ART UNIT PAPER NUMBER

3643

DATE MAILED: 10/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

*He*

## Office Action Summary

Application No.

10/692,835

Applicant(s)

FENNELLY, MARTINE

Examiner

Son T. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11, 19-32, 43, 53-57 and 60-65 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11, 19-32, 43, 53-57 and 60-65 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 3,5,8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding claim 3, the phrase "first and second pluralities" is unclear because pluralities of what? Claims 5,8 depend on claim 3, thus, same error.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. **Claims 1-2,4,6-7,9-11,19-20,22-25,27-29,31-32,43,53-57,60-63** are rejected under 35 U.S.C. 102(b) as being anticipated by Vasko et al.(US 4683709).

For claim 1, Vasko et al. teach a saddle pad apparatus 12 adapted to support a saddle while maintaining substantially unimpeded movement of the spinal column of a living subject, comprising a first plurality of pads 36 (col. 5, lines 5-8) disposed laterally to one side of the spine and a second plurality of pads 38 (col. 5, lines 5-8) disposed laterally to the other side of the spine, each of the pads being adapted to individually cooperate with a specific feature of the anatomy of the living subject.

For claim 2, Vasko et al. teach wherein said specific features comprise gaps or recesses in the subject's anatomy.

For claim 4, Vasko et al. teach wherein at least one of said pads varies in thickness (see fig. 8).

For claim 6, Vasko et al. teach wherein said plurality of pads are disposed in pockets 28,30 formed substantially between a first layer 14 and a second layer 17 of material.

For claim 7, Vasko et al. teach wherein said plurality of pads are made removable from said pockets via Velcro strips 34,35 disposed at seams of said pockets.

For claim 9, Vasko et al. teach wherein said living subject comprises an equine.

For claim 10, Vasko et al. teach wherein said apparatus is further adapted to mitigate rocking of said saddle back and forth on said living subject during riding.

For claim 11, Vasko et al. teach wherein said apparatus is further adapted to mitigate rocking of said saddle back and forth on said living subject during riding based at least in part on said variation in thickness.

For claim 19, Vasko et al. teach saddle pad apparatus 12 adapted to support a saddle on a living subject during riding such that said saddle is substantially stable around a rotational axis transverse to the longitudinal axis of the spinal column of said subject.

For claim 20, Vasko et al. teach wherein said apparatus comprises a plurality of pads 36,38 disposed laterally to said spine.

For claim 22, Vasko et al. teach wherein at least one of said pads varies in thickness (fig. 8).

For claim 23, Vasko et al. teach wherein at least a portion of said plurality of pads are formed from a visco-elastic foam material (col. 2, lines 65-68 and col. 3, lines 32-48).

For claim 24, Vasko et al. teach wherein said plurality of pads are disposed in pockets 28,30 formed substantially between a first layer 14 and a second layer 17 of material.

For claim 25, Vasko et al. teach wherein said plurality of pads are made removable from said pockets via Velcro strips 34,35 disposed at seams of said pockets.

For claim 27, Vasko et al. teach wherein said living subject comprises an equine.

For claim 28, Vasko et al. teach wherein said apparatus is further adapted to support said saddle while maintaining substantially unimpeded movement of the spinal column of said living subject.

For claim 29, Vasko et al. teach a saddle pad adapted for use with a saddle on an equine, comprising: first and second substantially flexible elements 14,17 having roughly the same shape, said first and second elements being bond together in at least a plurality of locations along their periphery said first element being in direct contact with the skin of said equine; and a plurality of compressible foam pad elements 36,38 disposed between said first and second flexibly elements, said pad elements being disposed within said saddle pad such that the movement of the spine of said equine is substantially unimpeded by said saddle and said pad elements during riding, wherein

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substantial weight redistribution of said saddle in a front-back direction is frustrated by said pad elements; and wherein said unimpeded spine movement, said frustration of redistribution, and said first flexible element cooperate to provide reduced discomfort for said equine during said riding.

For claim 31, Vasko et al. teach at least one peripheral ridge 19,26,22 disposed substantially along a front or back periphery of said first and second elements, said peripheral ridge cooperating with an edge of said saddle to substantially frustrate relative motion between said saddle pad and said saddle in at least one direction during riding.

For claim 32, Vasko et al. teach a saddle pad adapted for use, with a saddle, on an equine, comprising: first and second substantially flexible elements 14,17 having roughly the same shape, said first and second elements being bound together in at least a plurality of locations along their periphery, said first element being in direct contact with the skin of said equine; a plurality of compressible foam pad elements 36,38 disposed between said first and second flexibly elements, a first portion of the pad elements having a first shape and a second portion of the pad elements having a second shape, said pad elements being disposed within said saddle pad such that the movement of the spine of said equine is substantially unimpeded by said saddle and said pad elements during riding, first and second restraining straps 40,41 affixed to at least said second flexible element, said straps each being adapted for substantially concealed tethering to said saddle; and at least one peripheral ridge 19,26,22 disposed substantially along a front or back periphery of said first and second elements, said

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peripheral ridge cooperating with an edge of said saddle to substantially frustrate relative motion between said saddle pad and said saddle in at least one direction during riding; wherein said pad elements having said first shape are adapted to interface with gaps formed in the withers region of said animal, whereas said pad elements having said second shape are adapted to interface with gaps formed in the region of the animal directly under a rear portion of said saddle.

For claim 43, Vasko et al. teach tilt-inhibiting saddle pad apparatus, comprising: a body element 14,17 having a plurality of pockets 28,30 formed therein; a plurality of pad elements 36,38 disposed within respective ones of said pockets; and a contour element 19,22,26 (and the seams to create a boundary to hold in the pads) ndisposed within a respective one of said pockets, said contour element having physical properties adapted to cooperate with said pad elements and the anatomy of an animal on which said pad apparatus and a saddle are disposed to maintain said saddle in a substantially constant orientation with respect to said animal.

For claim 53, Vasko et al. teach a pad element 36,38 adapted for use in a saddle pad, wherein said pad element is formed from a substantially resilient material (col. 2, lines 65-68 and col. 3, lines 32-48) and is adapted for selective removal from said saddle pad by a user; and wherein said pad element is particularly shaped to substantially accommodate a particular withers region artifact on the anatomy of an animal on which said pad element and saddle pad is utilized.

For claim 54, Vasko et al. teach wherein said resilient material comprises a visco-elastic foam (col. 2, lines 65-68 and col. 3, lines 32-48).

For claim 55, Vasko et al. teach wherein said pad element has a plurality of densities associated therewith in its uncompressed state.

For claim 56, Vasko et al. teach wherein said plurality of densities are substantially stratified (fig. 8) with respect to the width dimension of said element.

For claim 57, Vasko et al. teach wherein said pad element further comprises a plurality of substantially rounded edges (self explanatory from figures).

For claim 60, Vasko et al. teach an apparatus adapted for use on high-withered animals, comprising: a substantially flexible pad 14,17 having a plurality of features 28,30 adapted to capture respective ones of pad elements; a plurality of pad elements 36,38 captured by respective ones of said features; wherein said pad elements and said pad are specifically adapted to raise a frontal portion of a saddle disposed over top of said pad element with respect to a withers region in order to mitigate tilting or rocking of the saddle.

For claim 61, Vasko et al. teach wherein said pad elements are formed from visco-elastic foam (col. 2, lines 65-68 and col. 3, lines 32-48).

For claim 62, Vasko et al. teach a pad interface 12 adapted to interface between said pad and said animal, said pad interface adapted to (i) dissipate localized pressure; (ii) dissipate heat; and (iii) dissipate moisture.

For claim 63, Vasko et al. teach a coordinated riding system for use on an animal, comprising: a pad retaining structure 12; a plurality of pad elements 36,38 retained by said structure and adapted to provide a substantially uniform distribution of pressure and withers support; and an interface element 17 disposed between said



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animal and said pad elements, said interface element being adapted to provide substantial pressure dissipation, moisture dissipation, and thermal dissipation.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 3,5,21,64** are rejected under 35 U.S.C. 103(a) as being unpatentable over Vasko et al. (as above).

Vasko et al. teach at least a portion of the gaps are disposed in the withers region of the subject (gaps exist in the wither area of the horse when a pad of such taught by Vasko is placed thereon) and plurality of pads are formed from a visco-elastic foam material (col. 2, lines 65-68 and col. 3, lines 32-48). However, Vasko et al. are silent about wherein said plurality comprises four discrete pads, two per side of the spine. It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ four pads in the saddle pad of Vasko et al., depending on the area of the horse one wishes to cushion. Note, the pads are adapted to cooperate with a recess or gap within the anatomy of the subject.

7. **Claims 8,26,30,65** are rejected under 35 U.S.C. 103(a) as being unpatentable over Vasko et al. (as above) in view of Woods (US 5802823).

Vasko et al. teach a fiber-based material 14 being disposed to contact said saddle. However, Vasko et al. are silent about material 17 being sheepskin disposed to

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contact the skin of said living subject. Woods teaches a saddle pad having a material 62 being sheepskin disposed to contact the skin of said living subject. It would have been obvious to one having ordinary skill in the art at the time the invention was made to manufacture the material 17 of Vasko et al. out of sheepskin as taught by Woods, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use (for comfort of the horse) as a matter of obvious choice.

### ***Response to Arguments***

8. Applicant's arguments filed 7/26/05 have been fully considered but they are not persuasive.

**Applicant argued that Vasko does not teach a plurality of pads one each side of the spine.**

Clearly in col. 5, lines 5-8, of Vasko et al., Vasko et al. teach plurality of pads that can either be placed in one pockets or a plurality of pockets for each pads.

**Applicant argued that Vasko in no way teaches or suggest each of the pad being adapted to individually cooperate with a specific feature of the anatomy of the subject.**

Vasko's pads are adapted to cooperate with a feature of the subject. For example, the pad 36 is adapted to cover the feature of the subject that the pad is laid upon, thus, adapted to cooperate. In addition, it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires

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the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

**Applicant argued that Vasko is in fact an exemplary instance of the prior art which Applicant's invention was intended to overcome; i.e., non-specific shaping or placement of insert pads. The inserts of Vasko broadly cover the back of the animal, with no strategic placement of shaping with respect to gaps or recesses formed in the animal's back.**

Vasko's inserts are covering whatever area on the horse's body intended to cover, thus, it is strategic placement of the insert based on the area of the horse's body. In addition, claim 1 states adapted language (see above in re Hutchinson), which the inserts of Vasko are adapted to cover any gaps since the inserts are pads just like Applicant's invention.

**Applicant respectfully traverses the Examiner's 102 rejection of Claim 19 over Vasko, in that Vasko in no way that Applicant can see even remotely teaches or suggests a saddle pad apparatus adapted to support a saddle on a living subject during riding such that said saddle is substantially stable around a rotational axis transverse to the longitudinal axis of the spinal column of said subject, as recited in Applicant's Claim 19.**

Vasko's saddle pad is secured on the horse by using straps either from the pad itself or the saddle (col. 2, lines 1-5,44-47, col. 4, lines 45-46), thus, is adapted to support such that the saddle is substantially stable around a rotational axis so that the pad will not tilt during riding. Based on reading the Vasko patent, especially col. 1, lines

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10-12 and col. 4, lines 45-46, it is inherent that the pad is secured tightly on the horse, thus, preventing substantial tilting during riding.

**Applicant submits that Vasko not only does not disclose mitigation of such gaps/tilting, but also in fact teaches away from the invention of Claim 19 by using pad inserts which run longitudinally all the way from the rear edge of the pad to the front edge of the pad. Regarding Fig. 8 of Vasko, only a small change in thickness is shown over the length of the insert and there is no teaching or suggestion that Applicant can find in Vasko that this is in any way meant to mitigate the aforementioned gaps/tilting described in detail by Applicant and claimed in Claim 19. Applicant respectfully requests that the Examiner specifically identify where in Vasko such recited functionality is taught, since the Examiner has to date provided no specific citations to this effect.**

Claim 19 merely states "Saddle pad apparatus adapted to support a saddle on a living subject during riding such that said saddle is substantially stable around a rotational axis transverse to the longitudinal axis of the spinal column of said subject.", so it is not clear how Applicant is arguing that claim 19 is described in detail regarding the pad inserts which run longitudinally all the way from the rear edge of the pad to the front edge of the pad and gaps/tilting described in detail by Applicant. There is nothing detailed about a claim that merely states adapted to language (see in re Hutchinson). As mentioned above, the straps holding the inserts of Vasko prevent rotational movement of the inserts while riding because Vasko discusses throughout his patent that the inserts are to be secured to the saddle. The claimed language of claim 19 is

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extremely broad with merely nothing but adapted language, which the pad of Vasko is adapted to performed.

**Applicant argued that Vasko in no way teaches or suggests that substantial weight redistribution of said saddle in a front-back direction is frustrated by the pad elements, as recited in Applicant's Claim 29. Applicant can find no teaching or suggestion in Vasko that weight redistribution (aka "tilting or rocking") is addressed or in any way controlled by the pad insert structure of Vasko. Applicant submits that a careful reading of Vasko indicates that the disclosed invention is focused entirely on shock/energy dissipation, and not weight redistribution. Applicant respectfully requests that the Examiner specifically identify where in Vasko such recited functionality is taught, since the Examiner has to date provided no specific citations to this effect.**

Although Vasko teach the pad is used for shock/energy dissipation, it is or it can also function to perform weight redistribution because it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). The structure of the pad of Vasko meets the structural limitation as claimed by Applicant, thus, the pad of Vasko can frustrate weight distribution even if Vasko does not intended that way.

**Applicant argued that Vasko in no way teaches or suggests and specific adaptation of the pad (inserts) to the withers region of the animal or any gaps/recesses formed therein, and in fact never even remotely discusses the**

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**withers region. Furthermore, Vasko teaches away from Applicant's amended Claim 32 from the standpoint that he teaches two inserts which run effectively the fore-aft length of the saddle, and hence in no way contemplates heterogeneous or mixed pad inserts as now recited in Claim 32.**

Again, Applicant's claimed language includes adapted to language, which the Examiner has already explained above that it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. The inserts of Vasko have the ability to perform the adapted to function as claimed by Applicant. The inserts of Vasko are placed in the wither area of the horse because that is the general position of the pad and saddle assembly, thus, the inserts are adapted to interface with gaps formed in the wither region of the horse. The claimed language does not positively claimed heterogeneous or mixed pad inserts as argued by Applicant. The claimed language merely states that a first portion of the pad elements having a first shape and a second portion having a second shape, which Vasko teaches because no where in the claimed language indicates that the shape are mixed or different. The language merely states a first shape and a second shape, which can be the same shape and not necessary different or mixed shape.

**Applicant argued that Vasko does not even appear to recognize that the saddle may tilt or rock (especially exacerbated by high-withered animals), let alone suggest a solution for this problem.**

From col. 1, lines 10-12, 43-45, col. 2, lines 1-5, col. 4, lines 44-46, one of ordinary skill can conclude that Vasko does recognize that the pad needs to be secured to the saddle, thus, prevents tilting or rocking. Even if not mentioned, why would anyone place a pad on a horse and not recognize a problem of tilting or rocking of the pad? Claim 60 states adapted to and functional language, which the apparatus of Vasko is adapted for use on high-withered animals.

**Applicant notes that there is a salient distinction between merely laying a pad (and broad insert) across the back of the animal, which may happen to include the withers region (Vasko), and specifically adapting the inserts to provide targeted support for, e.g. the gaps in the withers region (Applicant's Claim 63).**

Again, Applicant's claimed language includes adapted to language, which the Examiner has already explained above that it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

### **Conclusion**

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not


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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Son T. Nguyen whose telephone number is 571-272-6889. The examiner can normally be reached on Mon-Thu from 10:00am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter M. Poon can be reached on 571-272-6891. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Son T. Nguyen  
Primary Examiner  
Art Unit 3643

stn